

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SIEGFRIED FICHTNER, JURGEN HOFMANN,
KARL MUSSIG, AND DANIEL VERHOEVEN

Appeal 2006-2534
Application 10/789,411
Technology Center 2800

Decided: August 9, 2007

Before JOSEPH F. RUGGIERO, LANCE LEONARD BARRY,
MAHSHID D. SAADAT, ALLEN R. MACDONALD, and
JEAN R. HOMERE, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants request reconsideration of our Decision of
January 31, 2007, wherein we sustained the Examiner's rejection of the
appealed claims under 35 U.S.C. § 102(b).

We have carefully considered the arguments presented by Appellants
in the Request and reviewed our decision. However, those arguments do not

persuade us that our decision was in error in any respect or we have overlooked any relevant points in reaching our decision that the Examiner properly rejected claims 1 and 2 under 35 U.S.C. § 102 as anticipated by the applied prior art.

1. Scope of the Claim

It is Appellants' belief "that the Board appeared to treat claim 1 as a *process* claim." [Emphasis original.] (Request 2, ¶ 3). Appellants argue that the axial deflection of the laminations in Carlson only happens once during the manufacturing and cannot be equated with the claimed function of "to allow axial deflection" which is attributed to the recited end surface (*id.*).

We disagree and find that Appellants appear not to have considered the teachings of Carlson as a whole where the finished product has certain functionalities because of the manner in which the article was manufactured. Additionally, the claimed limitation of "attachment of a plate in such a manner as to allow an axial deflection of the laminations" merely requires axial deflection to be allowed, not actually occur nor to any specific degree. Here, although Carlson's washers dig into the shaft as the laminations tend to move apart after the pressure is removed (col. 3, ll. 6-11), their presence does not preclude allowing axial deflection of the laminations between the washers even if the laminations are to be pressed together using extra force. In other words, although the washers remain at their locations after their placement on the shaft, the laminations can be pressed together again and deflect axially. We also note that even if the degree of movement, bending, or deflection of the laminations in Carlson may be very small, the arrangement still allows *some* axial deflection in the same manner as the recited function.

2. *Claim Differentiation*

Appellants further argue that the language of claim 15, requiring that the inner diameter of the plate “bear upon an outer diameter of the shaft,” relates to a contact between the plate and the shaft (Request 3). Appellants further rely on doctrine of claim differentiation and assert that claim 1 has to be broader than claim 15 such that the limitation of “extending to an area of the shaft” can only mean no contact between the plate and the shaft (*id.*). In addressing the scope of the claims, Appellants rely on two recent court decisions which address the meaning of the terms used in separate claims and the use of doctrine of claim differentiation (*id.*).

The first decision suggests looking to and examining the intrinsic evidence, the claim language itself, the written description, and the prosecution history in determining the scope of the claims. *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014, 80 USPQ2d 1865, 1871 (Fed. Cir. 2006) (*quoting Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-17, 75 USPQ2d 1321, 1325-29 (Fed. Cir. 2005)). Although Appellants have not pointed to any specific part of this court decision which they believe to support their position, we address the scope of claims 1 and 15 consistent with its holding.

In our determination, we will give the claims their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. *See In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Here in the present case under appeal, looking at the language in claim 1 itself and giving the claim language its broadest reasonable interpretation, we note that the recitation of “extending to an area of the shaft” merely means that the plate

extends to a point which is an area of the shaft. Therefore, this area of the shaft may reasonably be interpreted as extending from a point close to the outer surface of the shaft to a point which is a part of the shaft.

The second decision Appellants rely on is *Andersen Corp. v. Fiber Composites LLC*, No. 00-2548, 2003 WL 21754817 at *1, 81 USPQ2d 1545 (Fed. Cir. 2007), which relates to the doctrine of claim differentiation. Appellants argue that since claim 15 depends upon claim 1 and requires contact between the plate and the shaft, claim 1 must be broader so that its recitation of “extending to an area of the shaft” can only mean that no contact exists between the plate and the shaft (Request 3).

While the *Andersen* court suggests that claims having different words or phrases are to be presumed to have different meaning and scope, the court also cautions against broadening claims beyond their correct scope as determined in light of the specification, the prosecution history, and any extrinsic evidence. *Andersen*, 2003 WL 21754817 at *3, 81 USPQ2d at 1552 (quoting *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1480, 45 USPQ2d 1429, 1434 (Fed. Cir. 1998)). *Multiform* further points to other cases where doctrine of claim differentiation did not require a difference in scope among the claims (*Id.* at 1434). See *Tandon Corp. v. United States Int’l Trade Comm’n*, 831 F.2d 1017, 1023, 4 USPQ2d 1283, 1288 (Fed. Cir. 1987) (allowing for two claims that are in different words to cover the same subject matter); *Moleculen Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1269, 229 USPQ 805, 810 (Fed. Cir. 1986) (affirming district court’s construction of a claim although it rendered a dependent claim redundant).

Additionally, we note that Patent and Trademark Office (PTO) is not required, in course of prosecution, to interpret claims in patent applications in same manner as courts interpret claims during infringement proceedings . Instead, the PTO applies to the language of proposed claims the “broadest reasonable interpretation” or the meaning in their ordinary usage as they would be understood by one of ordinary skill in art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by written description in applicant’s specification. *In re Morris*, 127 F.3d 1048, 1053-54, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (*citing In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989) and *In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984)). As such, during prosecution of the patent application, Appellants have the opportunity to make amendments to the claims in order to recite the claim language that precisely defines the scope of the claimed subject matter and distinguishes the claimed subject matter over the applied prior art.

In the present case, determining the scope of the claims in our opinion was specifically based on the broadest reasonable interpretation (*see* Decision 5). In particular, we found that claim 1 merely requires the plate to extend to an area of the shaft with no specific description of their contact area. Although the Specification discloses various embodiments with different contact configurations between the plate and the shaft (Specification ¶¶ 0035-0039), the claim language does not specifically delimit the contact configuration to such particular arrangements. Similarly, claim 15 merely requires an inner diameter of the plate to bear upon an outer diameter of the shaft, which does not preclude a plate touching the shaft and including a portion that may dig into the shaft, as shown by Carlson. See for

example, Figure 4 of Carlson showing the inner diameter of washer 13 in contact with the outer diameter of shaft 10 on the left side while the inner diameter of the washer on the right side of it digs into the shaft (col. 2, l. 51 through col. 3, l. 6). Therefore, according the claims their broadest reasonable interpretation without broadening the claims beyond their correct scope and considering the teachings of the prior art as a whole, we remain of the opinion that Carlson anticipates claims 1 and 15.

In conclusion, based on the foregoing discussion, we have granted Appellants' request to the extent that we have reconsidered our decision, but we deny Appellants' request to make any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

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